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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,030	03/02/2001	Horst Hintze-Bruning	IN-5453	7425

7590 04/15/2004

Basf Corporation  
26701 Telegraph Road  
Southfield, MI 48034-2442

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/762,030	<b>Applicant(s)</b> HINTZE-BRUNING ET AL.	
	<b>Examiner</b> Lawrence D Ferguson	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-11, 13-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed January 20, 2004.

Claims 1-4, 6-11, 13-16 and 18 are pending.

***Claim Rejections – 35 USC § 103(a)***

2. Claims 1-4, 6-11, 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0844286.
3. EP '286 discloses filmed powder coatings for substrates made of plastics (abstract) where the coatings are dry and free flowing (page 2, line 17) and have a melt temperature of 200 F (93.33°C) (page 2, lines 44-47). EP '286 discloses thermally cured powder coatings comprising a crosslinker (page 4, lines 36-53) which is a surfacer composition. The reference discloses the coatings as molten film over the substrate with coatings (page 11, lines 21-41) where the substrates are used as furniture (page 12, line 10), which are domestic appliances. The reference further discloses the substrate is a heat sensitive (thermoformable) plastic (thermoplastic) (page 12, line 11). Regarding claim 9, if desired, means this feature does not necessarily have to be met by the reference. With regard to claim 1, Applicant amends to read 'A laminatable film...the claimed film can be rolled up' and 'removable film' in instant claim 9. It is the position of the Examiner that these limitations constitute a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation,

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but only requires the ability to perform said feature. EP '286 does not show that the substrate has the thickness as shown in instant claims 1, 8 and 15. Thickness is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the durability of the film. As such, the thickness is optimizable. It would have been obvious to one of ordinary skill in the art to make the coated film with the limitations of the thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

4. Rejection made under 35 USC 103(a) as being unpatentable over EP 0844286 has been considered but is unpersuasive. Applicant argues there is no disclosure or suggestion for the substrate to be a film because a film has a different structure than an automotive part. EP '286 discloses the substrate is a heat sensitive (thermoformable) plastic (thermoplastic) (page 12, line 11). Although EP '286 does not explicitly teach the substrate is a film, Webster's New World Dictionary Third College Edition, defines a film as a surface, layer or coating. Based upon this definition Examiner upholds EP '286's coated substrate (layer) as a film comprising the same thermoplastic material as

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claimed. For this reason Examiner maintains, with regard to the limitation of the thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation and that it would have been obvious to one of ordinary skill in the art to make the coated film with the limitations of the thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

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272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISOR, PATENT EXAMINER  
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